

- Group II. Claims 5-14 and 44-45, drawn to a method of estimating genetic susceptibility to a developmental disability.
- Group III. Claims 15-18, drawn to a method of estimating genetic susceptibility to a developmental disability.
- Group IV. Claims 19-29, drawn to a method of estimating genetic susceptibility in an offspring.
- Group V. Claims 30-32, drawn to an isolated nucleic acid.
- Group VI. Claims 33-38 & 40-43, drawn to a PCR primer or an isolated nucleic acid that can distinguish between specific sequences.
- Group VII. Claim 39, drawn to an isolated nucleic acid for simple hybridization.

Responsive to the Requirement for restriction, Applicant elects to prosecute the invention of Group IV, with traverse, Claims 19-29, which are drawn to a method of estimating genetic susceptibility in an offspring.

Applicant respectfully requests reconsideration of the Requirement for Restriction, or in the alternative, modification of the Restriction Requirement to allow prosecution of more than one group of Claims designated by the Examiner in the present Application, for the reasons provided as follows.

Under 35 U.S.C. §121 "two or more independent and distinct inventions ... in one Application may ... be restricted to one of the inventions." Inventions are "'independent'" if "there is no disclosed relationship between the two or more subjects disclosed" (MPEP 802.01). The term "'distinct'" means that "two or more subjects as disclosed are related ... but are capable of separate manufacture, use or sale as claimed, AND ARE PATENTABLE OVER EACH OTHER" (MPEP 802.01) (emphasis in original). However, even with patentably distinct inventions, restriction is not required unless one of the following reasons appear (MPEP 808.02):

1. Separate classification
2. Separate status in the art; or
3. Different field of search.

Further, under Patent Office Examining Procedures, "[i]f the Search and Examination of an entire Application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions" (MPEP 803, Rev. 8, May 1988) (emphasis added).

Applicant respectfully submits that the groups designated by the Examiner, although admitted patentably distinct, fail to define compositions, with properties so distinct as to warrant separate Examination and Search. Claims 1-4 and 46-47 of Group I are drawn to a method of generating a genetic reference data set that are fundamentally related to Claims 19-29 of Group IV, drawn to a method of estimating genetic susceptibility in an offspring. The search for any of the methods separately classified by the Examiner as the invention of Group I would require an additional search of the identical classes wherein the methods of Group IV are classified, thus resulting in a duplicate search for the same material. Thus, Applicant submits that the Search and Examination of the entire Application, or, at least, of Group I with Group IV can be made without serious burden, and therefore the Examiner must examine all of the claims of the Application on the merits.

The Examiner's assertions to the contrary notwithstanding, Applicant respectfully submits that conjoint examination and inclusion of all of the Claims of the present Application would not present an undue burden on the Examiner, and accordingly, withdrawal of the Requirement for Restriction, or, at the least, modification to include the Claims drawn to Group I and Group IV is in order.

The Examiner has further required an election of species for Groups I, II, III, and IV. Solely to comply with the Examiner's requirement the Applicants make the following elections without traverse:


- A. Our election of a specific disease is Schizophrenia.
- B. Our election of either a protein or nucleic acid is a Nucleic Acid.
- C. Our election of a treatment or non-treatment is for a Non-Treatment.

The Applicants believe Claims 1-4 and 46-47 of Group I, and Claims 19-29 of Group IV are all readable on these three elections.

No fees are believed to be necessitated by the foregoing Response. However, should this be erroneous, authorization is hereby given to charge Deposit Account No. 11-1153 for any underpayment, or credit any overages.

In view of the above, withdrawal of the Requirement for the Restriction is requested, and an early action on the merits of the Claims is courteously solicited.

Respectfully submitted,

  
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Date: October 23, 2001